

Remarks

This communication is responsive to the Final Office Action of April 24, 2009, and to the Advisory Action of September 2, 2009. Reexamination and reconsideration of the amended claims is respectfully requested.

Status of Claims

Claims 1-5, 7-8 and 38-41 are pending for examination.

Claims 1, 38, and 40-42 are amended herein.

Claim 6 is cancelled.

Claims 9-37 were previously withdrawn.

Claims 1, 38, and 40-42 are in independent form.

Summary of the Advisory Action

The Advisory Action of September 2, 2009 stated that the response to Final Office Action of July 2, 2009 raised new issues that would require further search and consideration. The amendments made in the response were consistent with what was included in the specification of the subject application and thus did not in fact raise new issues or require further searching.

The Advisory Action of September 2, 2009 also stated that the amendment to the specification dated 1/28/09 raised a new matter issue because the original file specification describes that the adjustor paddles 14a and 15a **may** be used in both the sample arm 14 and reference arm 15.

Claims 1-8 and 38-41 were rejected under 35 USC §103(a) as purportedly being unpatentable over Everett et al (WO 00/69333) (Everett) in view of "Polarization Effects in Optical Coherence Tomography of Various Biological Tissues," Johannes F. de Boer (Boer).

The Proposed Amendments Did Not Create New Issues For Search

The Advisory Action of September 2, 2009 stated that the response to Final Office Action of July 2, 2009 raised new issues that would require further search and consideration. This is incorrect.

The limitation added to the independent claims appeared in originally filed claim 6. The embodiment described in amended claim 1 is consistent with the originally filed figures. It is very difficult, if not impossible, to understand how an Office Action can assert that searching an independent claim that is rewritten to include a limitation from a dependant claim can raise a new search issue. Especially when the embodiment described in amended claim 1 appeared in the originally filed figures. Presumably the dependent claim was already searched? Indeed, in the 4/24/09 Office Action, claim 6 was rejected. To be rejected the claim must have been searched. Therefore, it is impossible to assert that moving the limitation from claim 6 to claim 1, from which claim 6 depended, can raise a new issue.

The 1/28/09 Amendment Does Not Raise New Matter Issues

The Advisory Action of September 2, 2009 stated that the amendment to the specification dated 1/28/09 raised a new matter issue because the original file specification describes that the adjustor paddles 14a and 15a **may** be used in both the sample arm 14 and reference arm 15.

The 1/28/09 amendment to the specification removed the sentences that read:

Fiber polarization adjustors (paddles) 14a, 15a in both the sample and reference arms 14, 15 may be used to maximize the light power incident upon the sample 20 and the optimum interference of sample and reference arm light, respectively. However, measurement of retardation and fast axis does not depend upon ideal alignment of the paddles.

These sentences were removed to harmonize the specification with the figures, which did **not** show the adjustors in both arms. The remarks in the 1/28/09 amendment

state that "these amendments make more clear that the polarization adjusting device resides in the sample arm and comprises both the linear polarizer and the adjustable waveplate."

Therefore, deleting the two sentences from the specification on 1/28/09 did not raise a new matter issue, but rather made the application more internally consistent and more focused on the preferred embodiment, where the polarization adjusting device resides in the sample arm.

While the specification may have originally illustrated different embodiments, and while the claims may have originally included different embodiments, both the figures as originally filed and claim 6 as originally filed make clear that there were alternative embodiments, including the embodiment where there are no polarization adjusting devices in the reference arm. The RCE and preliminary amendment are intended to focus on the embodiment where the polarization adjusting device resides in the sample arm.

Rather than being an introduction of new matter, or rather than being an issue that requires an additional search, these amendments actually make the Examiner's job easier by more narrowly focusing the invention. Therefore Applicant respectfully requests that the next Office Action desist from the new matter and new issue statements and instead focus on the amended claims.

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §103

Claims 1-8 and 38-41 were rejected under 35 USC §103(a) as purportedly being unpatentable over Everett in view of Boer.

To establish a prima facie case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

When establishing a prima facie case of obviousness the Office must clearly articulate the reason(s) the claimed invention would have been obvious. MPEP 2142 recites that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at 418, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Here, the criteria for establishing a prima facie case of obviousness are not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach "where the reference arm is absent addressable polarization selecting components." Thus, none of the claims are obvious for at least this reason.

The Prior Art Fails To Teach No Addressable Polarization Selecting Components In The Reference Arm

The claims recite, "where the reference arm is absent **addressable** polarization selecting components." (Emphasis added). Neither Everett nor Boer teach or suggest this claim limitation. Examination of Everett shows that Everett teaches, "the wave plate 16 makes the polarization state adjustable. Any polarization state can be used: circularly polarized, elliptically polarized, or linearly polarized." (Everett page 8 lines 27-29; figure 1, element 16). One of ordinary skill in the art would appreciate that Everett teaches using an addressable polarization selecting component in the reference since the wave plate taught by Everett "**makes the polarization state adjustable.**" Thus, Everett teaches the use of addressable polarization selecting components in the reference arm. Boer does not remedy the shortcomings of Everett. Thus, the combination of Everett and Boer does not teach or suggest "where the reference arm is absent polarization adjusting components." Therefore, the Office Action has not presented a prima facie case of obviousness. Accordingly, the claims are allowable.

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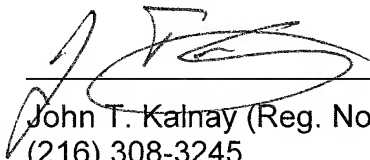
Applicant(s): ROTH et al.
Examiner: JOHN F. RAMIREZ
Art Unit: 3737

Conclusion

For the reasons set forth above, the claims are now in condition for allowance.
An early allowance of the claims is earnestly solicited.

Respectfully submitted,

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